

discuss the reasons underlying the double-patenting rejection of claim 29 over claim 5 of U.S. Patent 6,778,969 (over which applicants filed on January 18, 2006 a Terminal Disclaimer) and over claim 6 of U.S. Patent 6,611,820 (in view of the arguments presented in the Request for Reconsideration filed January 18, 2006). As a result of the aforementioned telephone exchanges, Examiner Dixon, by telephone message of June 1, 2006, finally suggested that applicants' attorney simply restate the arguments presented over the '820 patent for reconsideration, as a response to the Office Action mailed March 17, 2006. Accordingly, this Request for Reconsideration includes those arguments.

1. The Office Action pointed out that an insufficient Terminal Disclaimer Fee had been paid with the Response filed January 18, 2006. The PTO is hereby authorized to charge any fees due in connection with the previously-filed Terminal Disclaimer, or any other fee for the present application, or credit any overpayment herein to Deposit Account 19-4293. This continuing authorization should moot the fee payment issue raised in the Office Action.

2. Applicants note and appreciate the indication that claims 29-34 are allowable, that statement apparently referring to allowability over O'Connor U.S. Patent 5,745,568, as stated in point 4. on page 3 of the Office Action.

3. Claim 29 was rejected under the judicially-created doctrine of double-patenting over (1) Claim 5 of U.S. Patent 6,778,969, and (2) Claim 6 of U.S. Patent 6,611,820. The Office Action alleged that the subject matter claimed in the present application is fully disclosed in “the patent” (sic, the two ‘969 and ‘820 patents) “since the patent and the application are claiming common subject matter.” The Office Action further alleges that there is no apparent reason why applicant was prevented from earlier presenting corresponding claims during prosecution of the application which matured into a patent.

First, applicants note that on January 18, 2006, they already filed in this application a Terminal Disclaimer over U.S. Patent 6,778,969. Thus, there is no basis in this record for the double-patenting rejection re-stated in the March 17, 2006 Office Action, insofar as it is based on U.S. Patent 6,778,969. Accordingly, that rejection, insofar as it is based upon the ‘969 patent, is moot, and applicants respectfully request that it be withdrawn.

With respect to the double-patenting rejection of claim 29 over claim 6 of Oshima et al. U.S. Patent 6,611,820, applicants first incorporate herein by reference the remarks on that issue stated in pages 2 and 3 of the Request for Reconsideration filed herein on January 18, 2006. In addition to those prior remarks, applicants again hereby emphasize the following points:

Applicants note, that in neither the Office Action of October 18, 2005 (to which the Request for Reconsideration filed January 18, 2006 was responsive), or in the Office Action of March 17, 2006 (to which the present Request for Reconsideration is responsive) has a factual basis for the double-patenting rejection based upon '820 claim 6 been stated.

Applicants again, attached hereto, present a claim chart comparing the language of claim 29 of the present application to the language of '820 claim 6. We note that parts (b) and (e) of the language of '820 claim 6 have been corrected in this chart over the corresponding chart filed January 18, 2006.

As previously pointed out, pending claim 29 includes [part (c)]:

means for reading disk identification information recorded by a second modulation method in a second recording area of the optical disk said means including an optical head which is also capable of reading information recorded in the first recording area.

whereas no such means is recited in '820 claim 6.

And, although '820 claim 6 does include some "encrypting means," it does not include

means for encrypting information using at least a cipher key and said disk identification information unique to the same optical disk

as recited in applicants' claim 29 [part (d)]. Neither a cipher key nor disk identification information is used in '820 claim 6 for encrypting. Note also that the "certain

information. . . stored in the recording medium" is used in '820 claim 6 only for certifying validity of a recording medium, not for encrypting.

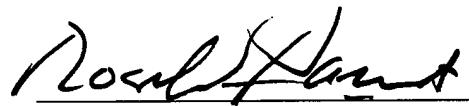
In applicants' claim 29, there are "means for permitting recording. . . after confirming the content of a recording permission code in an input signal to said means for recording," whereas in '820 claim 6, the recording means is operable "after the validity fo the recording medium is certified" based on "information stored in the recording medium."

All of the above-explained differences between applicants' claim 29 and '820 claim 6 demonstrate that claim 29 is patentably distinct from '820 claim 6. Accordingly, reconsideration and withdrawal of the double-patenting rejection based on '820 claim 6, are respectfully requested.

Serial No.: 09/964,378

Should the Examiner deem that any further action by applicants would be desirable for placing this application in even better condition for issue, the Examiner is requested to telephone applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Roger W. Parkhurst  
Roger W. Parkhurst  
Registration No. 25,177

June 16, 2006

Attorney Docket No.: 28951.2011/ C8

STEPTOE & JOHNSON LLP  
1330 Connecticut Avenue NW  
Washington DC 20036-1795  
Tel: (202) 429-6420